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REMARKS

Claims 1, 4, 6, 9, 11, and 14 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Foladare, *et al.* (U.S. Patent 6,311,210), in view of Moran, *et al.*, (U.S. Pub. 2003/0104827), and in view of Segur (U.S. Patent 6,212,550). As will be shown below, neither Foladare, Moran, nor Segur, either alone or in combination, teaches or suggests a method, system, or computer program product for email administration as claimed in the present application. Claims 1, 4, 6, 9, 11, and 14 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1, 4, 6, 9, 11, and 14.

Claims 2, 3, 5, 7, 8, 10, 12, 13, and 15 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Foladare, *et al.* (U.S. Patent 6,311,210), in view of Moran, *et al.*, (U.S. Pub. 2003/0104827), in view of Segur (U.S. Patent 6,212,550), and further in view of Tsai (U.S. Patent 6,839,741). As will be shown below, neither Foladare, Moran, Segur, nor Tsai, either alone or in combination, teaches or suggests a method, system, or computer program product for email administration as claimed in the present application. Claims 2, 3, 5, 7, 8, 10, 12, 13, and 15 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 2, 3, 5, 7, 8, 10, 12, 13, and 15.

Claim Rejections – 35 U.S.C. §103

To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed.

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Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Foladare, Moran, and Segur

Claims 1, 4, 6, 9, 11, and 14 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Foladare, *et al.* (U.S. Patent 6,311,210), in view of Moran, *et al.*, (U.S. Pub. 2003/0104827), and in view of Segur (U.S. Patent 6,212,550). The proposed combination of Foladare, Moran, and Segur cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claims of the present application, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination of Foladare, Moran, and Segur. The combination of Foladare, Moran, and Segur therefore does not establish a prima facie case of obviousness. The rejection of claims 1, 4, 6, 9, 11, and 14 should therefore be withdrawn and the case should be allowed.

The Combination Of Foladare, Moran, and Segur
Does Not Teach All Of Applicants' Claim Limitations Of Claim 1

Foladare

To establish a prima facie case of obviousness, the proposed combination of Foladare, Moran, and Segur must disclose all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Independent claim 1 claims:

1. A method of email administration comprising the steps of:

receiving through a transcoding gateway an email message,
wherein

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the email message comprises at least one digital object having a digital object type;

the transcoding gateway is coupled to one or more display devices, and

the transcoding gateway comprises, for each display device, a display device record comprising display format attributes of each display device, wherein the display format attributes include a display format type for each display device;

finding a display device record for a destination display device, wherein the destination display device comprises a display device having a display format type that is the same as the digital object type;

transcoding the digital object in dependence upon the display format attributes of the destination display device; and

displaying the transcoded digital object on the destination display device.

Regarding the rejection of claim 1, the Office Action at page 2 states that Foladare at column 4, lines 35-37, reference number 160, and column 3, lines 15-16 teaches:

Receiving (via means-200, col. 4 l. 35-37, recorded on a medium as described in col. 7 l. 28-41) through a transcoding gateway (160) an email message (col. 3 ll. 15-16)...

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The cited section of the Office Action takes the position that reference number 160 of Foladare teaches a “transcoding gateway” as claimed in independent claim 1. Column 2, line 51, of Foladare actually describes that reference number 160 is a “centralized mail device 160.” Foladare at column 3, lines 15-16, also states that “[t]he centralized mail device 160 receives the electronic mail message from the user device 100” and Foladare at column 3, lines 37-39, states that “the centralized mail device 160 sends portions of the electronic mail message stored in memory to the designated electronic mail receiving devices 120-150.” The centralized mail device of Foladare parses an incoming email into portions and forwards those portions to various mail receiving devices. The centralized mail device of Foladare that parses incoming email messages and forwards those portions to various mail receiving devices does not teach a transcoding gateway as claimed in the present application. The references to Foladare cited in the Office Action therefore cannot teach receiving through a transcoding gateway an email message as claimed in the present application. Foladare therefore does not teach each and every element of independent claim 1 and the rejection should be withdrawn.

The Office Action at page 2 also states that Foladare at reference numbers 160, 302, and 120-150 teaches:

the transcoding gateway (160) is coupled to one or more display devices (302, 120-150)...

As mentioned above, however, what reference number 160 of Foladare actually teaches, as indicated at column 3, lines 15-16, and column 3, lines 37-39, is a “centralized mail device 160” that parses an incoming email into portions and forwards those portions to various email receiving devices. The centralized mail device of Foladare that forwards portions of email to email receiving devices does not teach a transcoding gateway. The references of Foladare cited by the Office Action therefore cannot teach the transcoding gateway is coupled to one or more display devices as claimed in the present application. Foladare therefore does not teach each and every element of independent claim 1 and the rejection should be withdrawn.

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The Office Action at pages 2-3 also states that Foladare at Figure 3, column 5, lines 11-15, and column 6, lines 37-40, teaches:

transcoding gateway comprises, for each display, a display device record (fig. 3) comprising display format attributes (303, file extensions, col. 5 ll. 11-15, col. 6 ll. 37-40) of each display device (302, 120-150), wherein the display format attributes (303, file extensions, col. 5 ll. 11-15, col. 6 ll. 37-40) include a display format type for each display device (e.g. display format type equates to file extensions such as .doc .exe .bmp etc.)...

As indicated at column 5, lines 9-10 and lines 27-28, what Figure 3 of Foladare actually discloses, is "an exemplary data structure of the profile database 165" and that "controller 200 retrieves the profile information for the retrieving party from the profile database 165...." That is, the profile database of Foladare stores profile information for a party receiving an email. The record depicted in Figure 3 of Foladare is a party profile record, not the display device record of claim 1. The party profile record of Foladare does not teach a display device record as claimed in the present application. Foladare therefore does not teach each and every element of independent claim 1 and the rejection should be withdrawn.

The Office Action at page 3 also states that Foladare at column 6, lines 21-40, teaches:

finding a display device (by way of means on a recorded medium-200 & 160 col. 7 l. 28-41) record for a destination display device (e.g. destination display device is a recipient of email message with an attachment), wherein the destination display device comprises a display having a display format type (e.g. display format type equates to file extensions such as .doc .exe .bmp etc.) that is the same as the digital object type (e.g. attachment, files, bitmap documents etc, which have same file extensions such as .doc, .exe .bmp etc., col. 6 ll. 21-40)...

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What column 6, lines 21-40, of Foladare actually discloses is that “the centralized electronic mail device 160 of the present invention may also determine which devices are to receive any attachments to the electronic mail message...whether or not to send attachments, which type of attachments to send, and the like.” Foladare at column 6, lines 21-40, however, does not mention “finding a display device record for a destination display device” as claimed in the present application. In fact, Foladare never mentions, not even once, “finding a display device record.” Foladare’s determination of which devices are to receive any attachments, whether or not to send attachments, or which types of attachments to send is not finding a display device record for a destination display device of the present application. Foladare therefore does not teach each and every element of independent claim 1 and the rejection should be withdrawn.

The Office Action at page 3 also states that Foladare at column 6, lines 55-57, teaches:

displaying the digital object on the destination display device (col. 6 ll. 55-57)...

What column 6, lines 55-57, of Foladare actually teaches is that “Steve then retrieves the electronic mail message, or portions thereof, using at least one of the electronic mail receiving devices 120-150.” Claim 1 of the present application claims displaying a transcoded digital object, not the retrieving an email of Foladare. Foladare’s disclosure of retrieving an email does not teach displaying a transcoded digital object as claimed in the present application. Foladare therefore does not teach each and every element of independent claim 1 and the rejection should be withdrawn.

Moran

The Office Action at page 3 states that Moran at reference numbers 70 and 75, teaches:

receiving through a transcoding gateway (70) an email message (75)...

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What reference number 70 actually teaches at paragraph 0026 and Figure 3A of Moran is a "third party message rerouting/reformatting service 70" that includes a "data extractor and message reformatter 96." Moran at paragraph 0038 states that "data extractor and message reformatter 96 will reformat e-mail message 75 in a block 114 to produce a destination message 98" that generally "will comprise an SMS message, an e-mail message, or an instant message." Moran at paragraph 0030 explains that "[m]essages 98 are then sent to a selected destination device...." that typically include, as indicated at paragraph 0009, "cellular phones, pagers, wireless PDA's, Pocket PC's, and wireless laptops." Moran is merely concerned with reformatting the text of an email message for viewing by various wireless devices. Claim 1 of the present application claims transcoding a digital object, not reformatting the text of an email message. Reformatting the text of an email message is not transcoding a digital object as claimed in the present application. Similarly, the 'rerouting/reformatting service 70' of Moran is not a transcoding gateway as claimed in the present application. 'Rerouting/reformatting service 70' and 'email messages 75' of Moran therefore do not teach receiving through a transcoding gateway an email message as claimed in the present application. Moran therefore does not teach each and every element of independent claim 1 and the rejection should be withdrawn.

The Office Action at page 3 also states that Moran at reference numbers 70, 38, 48, 87, 89, 91, and 93 teaches:

the transcoding gateway (70) is coupled to one or more display devices
(38, 48, 87, 89, 91, 93)...

As mentioned above, what reference number 70 of Moran actually teaches is a "third party message rerouting/reformatting service 70" that reformats the text of an email message. Claim 1 of the present application claims transcoding a digital object, not reformatting the text of an email message. Reformatting the text of an email message is not transcoding a digital object as claimed in the present application. The

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'rerouting/reformatting service 70' of Moran therefore is not a transcoding gateway as claimed in the present application. Moran therefore does not teach each and every element of independent claim 1 and the rejection should be withdrawn.

The Office Action at page 3 also states that Moran at reference numbers 70, 38, 48, 87, 89, 91, 93, 80, 82, 81, 84-94, 90 and paragraphs 0029, 0030, and 0037 teaches:

the transcoding gateway (70) comprises, for each display device (38, 48, 87, 89, 91, 93), a display device record (80, 82, 81, 84-94 [0029]) comprising display format attributes of each device (90 e.g. capability information [0029-0030], [0037])...

As mentioned above, what reference number 70 of Moran actually teaches is a "third party message rerouting/reformatting service 70" that reformats the text of an email message. Claim 1 of the present application claims transcoding a digital object, not reformatting the text of an email message. Reformatting the text of an email message is not transcoding a digital object as claimed in the present application. The 'rerouting/reformatting service 70' of Moran therefore is not a transcoding gateway as claimed in the present application. Moran therefore does not teach each and every element of independent claim 1 and the rejection should be withdrawn.

The Office Action at page 4 states that Moran at paragraphs 0030 and 0038 teaches:

transcoding (via means disclosed in [0030] on recording medium disclosed in [0060-0063]) the *email message* in dependence upon the display format attributes (e.g. device capabilities) of the destination display device ([0030][0038])...[emphasis added]

Claim 1 of the present application, however, claims transcoding a digital object, not transcoding an email as cited by the Office Action. As mentioned above, an email is not a digital object as claimed in the present application. Transcoding an email message as

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cited by the Office Action does not teach transcoding a digital object as claimed in the present application. In addition, what paragraphs 0030 and 0038 of Moran actually teach is that “data extractor and message reformatter 96 will reformat e-mail message 75 in a block 114 to produce destination message 98” and that “[m]essages 98 are reformatted to meet the particular requirements of the service provider for a selected destination device....” That is, Moran is concerned with reformatting the text of an email message to comply with a service provider’s protocol for transmitting text to a destination device serviced by the service provider. Moran’s reformatting the text of an email message is not transcoding a digital object as claimed in the present application. Moran therefore does not teach each and every element of independent claim 1 and the rejection should be withdrawn.

The Office Action at page 4 states that Moran at paragraph 0038 teaches:

displaying the transcoded *email message* (e.g. destination message) on the destination display device ([0038])...[emphasis added]

Claim 1 of the present application, however, claims displaying a transcoded digital object, not displaying a transcoded email as cited by the Office Action. As mentioned above, an email is not a digital object as claimed in the present application. Displaying the transcoded email message as cited by the Office Action does not teach displaying a transcoded a digital object as claimed in the present application. In addition, what paragraph 0038 of Moran actually teaches is “that “data extractor and message reformatter 96 will reformat e-mail message 75 in a block 114 to produce destination message 98.” That is, Moran at paragraph 0038 is concerned with reformatting an email, not displaying a transcoded digital object. In fact, paragraph 0038 never once mentions ‘displaying’ anything. Moran’s reformatting an email does not teach displaying a transcoded digital object on a destination display device as claimed in the present application. Moran therefore does not teach each and every element of independent claim 1 and the rejection should be withdrawn.

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Segur

Regarding the rejection of claim 1, the Office Action at page 4 also states that Segur at reference numbers 10, 16, 12, and 14 teaches:

receiving through a transcoding gateway (10) an email message (16, 12, 14 all electronically sent mail messages including email video mail and voice mail)...

The Office Action therefore takes the position that reference numbers 12 and 14 of Segur teach the email message of claim 1 of the present application. What reference numbers 12 and 14 of Segur actually teach according to column 2, lines 3-4, are "video mail messages 12" and "voice mail messages 14." The first element of claim 1 of the present application claims "receiving...an email message," not a video mail message and not a voice mail message. The video mail message of Segur and the voice mail message of Segur do not teach an email message as claimed in the present application.

In addition, the Office Action takes the position that reference number 10 teaches the transcoding gateway of claim 1 of the present application. What reference number 10 of Segur actually teaches according to column 1, line 66-67, is a "multi-format communications client-server 10." According to Segur at column 2, lines 62-63, the multi-format communications client-server "converts stored text messages (e.g., email, fax) to voiced messages." Segur at column 2, line 65, through column 3, line 2, also states that the multi-format communications client-server "converts messages in a first data format to a second data format. For instance, the data conversion processor would convert from a pager data format (pager data) to an email data format." In other words, the multi-format communications client-server of Segur converts the text of an email message to a synthesized voice message and to text for display on other devices. Claim 1 of the present application claims transcoding a digital object, not converting the text of an email message. As mentioned above, a digital object as claimed in the present application is not the text of an email message. Transcoding a digital object as claimed in

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the present application therefore cannot be Segur's converting the text of an email. Because Segur does not teach transcoding a digital object, Segur cannot teach a transcoding gateway. Segur's multi-format communications client-server therefore does not teach a transcoding gateway as claimed in the present application. Segur therefore does not teach each and every element of independent claim 1 and the rejection should be withdrawn.

The Office Action at page 4 states that Segur at reference numbers 12, 14, and 16 teaches:

wherein the email message (16, 12, 14 all electronically sent mail messages including email, as well as video mail and voice mail) comprises at least one digital object (e.g. In the case of email messages video and voice mail, a digital object is a voice and video component transmitted with the message respectively) having a digital object type (e.g. types includes voice, video, text etc associated with the message)...

The Office Action therefore takes the position that reference numbers 12 and 14 of Segur teach "an email message" of claim 1 of the present application. What reference numbers 12 and 14 of Segur actually teach according to column 2, lines 3-4, are "video mail messages 12" and "voice mail messages 14." The first element of claim 1 of the present application claims "receiving...an email message," not a video mail message and not a voice mail message. An email message is completely different than a video mail message or a voice mail message. The email message of Segur conveys text to the recipient, while Segur's voice and video mail messages convey audio data, alone or in combination with video data. The video mail message of Segur and the voice mail message of Segur do not teach an email message as claimed in the present application.

The Office Action states at page 4 that "[i]n the case of email messages video and voice mail, a digital object is a voice and video component transmitted with the message respectively...." Applicants respectfully disagree with the Office Action's assertion. An

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email message as claimed in the present application includes at least one digital object. Nothing in Segur, however, teaches that the video mail message or voice mail message is included in an email message. In fact, Segur at column 1, line 67, through column 2, line 6, indicates that video mail messages and voice mail messages are from different sources and have different formats than email messages by stating:

The client-server 10 receives messages from a variety of sources in a variety of communication formats (plurality of data formats). For instance, a subscriber may receive video mail messages 12, voice mail messages 14, electronic mail messages 16, pager messages 18, broadcast service messages 20, PDA messages 22 and fax messages 24.

Segur's listing video mail messages, voice mail messages, and email messages as examples of messages from different sources and having different formats demonstrates that voice mail messages, video mail messages, and email messages are distinct types of messages. Because voice mail messages, video mail messages, and email messages are distinct types of messages, Segur teaches away from the idea that voice mail messages and video messages are included in an email message. Segur's voice mail messages and Segur's video mail messages therefore do not teach a digital object as claimed in the present application. Segur therefore does not teach each and every element of independent claim 1 and the rejection should be withdrawn.

The Combination Of Foladare, Moran, and Segur
Does Not Teach All Of Applicants' Claim Limitations Of Claim 4

Claim 4 of the present application claims:

4. The method of claim 1 wherein displaying the transcoded digital object on the destination display device further comprises writing the transcoded digital object to display memory.

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Regarding the rejection of claim 4, the Office Action at page 5 states that Foladare at reference number 203, column 3, lines 34-40, and column 4, lines 22-26, teaches:

wherein displaying the transcoded digital object on the destination display device further comprises writing the transcoded digital object to display memory (Foladare et al. – 203, col. 3 l. 34-40, col. 4 l. 22-26)...

What column 3, lines 34-40, of Foladare actually teaches is that “the centralized electronic mail device 160 sends portions of the electron mail message stored in memory to the designated electronic mail receiving devices 120-150.” As mentioned above, the centralized mail device of Foladore parses an incoming email into portions and forwards those portions to various mail receiving devices.

What reference 203 and column 4, lines 22-26, of Foladare actually teach is that “[t]he centralized electronic mail device 160 includes ... a memory 203” such that “memory 203 contains control programs for controlling the operation of the centralized electronic mail device 160 and provides a storage for electronic mail message data and profile information retrieved from the profile database 165.” The ‘memory 203’ of Foladare therefore stores the computer program instructions for parsing an incoming email into portions and forwarding those portions to various mail receiving devices and stores data retrieved from a database. Claim 4 of the present application claims writing the transcoded digital object to display memory, not storing data retrieved from a database and not storing computer program instructions for parsing and forwarding portions of an email. Foladare’s storing of data retrieved from a database and of such computer program instructions does not teach writing the transcoded digital object to display memory as claimed in the present application.

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No Reasonable Expectation Of Success In The
Proposed Combination Of Foladare, Moran, and Segur

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Foladare, Moran, and Segur. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The present application is entitled "Routing Digital Email Objects Within A Client Device" and independent claim 1 includes "transcoding a digital object in dependence upon the display format attributes of the destination display device...." Foladare discloses a centralize mail device that parses incoming email messages and forwards those portions to various mail receiving devices. Foladare at column 3, lines 15-16 and lines 37-39. Moran discloses a third party message rerouting/reformatting service that reformats the text of an email message for viewing by various wireless devices. Moran at reference number 70 and paragraphs 0030 and 0038. Segur further discloses a multi-format communications client-server that converts the text of an email message to a synthesized voice message and to text for display on other devices. Segur at reference number 10 and column 2, lines 62-63, and column 2, line 65, through column 3, line 2. The centralized mail device of Foladare, the third party message rerouting/reformatting service of Moran, and the multi-format communications client-server of Segur will not work to transcoding a digital object in dependence upon the display format attributes of the destination display device as claim in the present application. The proposed combination of Foladare, Moran, and Segur therefore cannot support a prima facie case of obviousness. The rejection should be withdrawn and the case should be allowed.

No Suggestion Or Motivation To Combine
Foladare, Moran, and Segur

There is no suggestion or motivation to combine Foladare, Moran, and Segur. To establish a prima facie case of obviousness under 35 U.S.C. § 103 there must be a suggestion or motivation to combine Foladare, Moran, and Segur. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to

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combine Foladare, Moran, and Segur must come from the teaching of either Foladare, Moran, or Segur themselves, and the Examiner must. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action states no rationale for motivation to combine Foladare, Moran, and Segur other than an assertion at page 4, which states:

It would be obvious to one of ordinary skill in the art at the time of the invention to modify Moran et al by Segur in order to translate a message (e.g. which includes voice, video, text objects) in a format required by a user (col. 4 ll. 10-20) and further it would be obvious to one of ordinary skill in the art at the time of the invention to modify Foladare et al. by *transcoding email message based on display format attribute taught by* Moran et al. in view of Segur in order to allow users to send message from their devices to other service provider devices that contain different attributes than the sending device (abs, col. [0008][030]).

The office action fails to explicitly point to the teaching within Foladare, Moran, or Segur suggesting the proposed combination. Without more, the rejection should be withdrawn.

The actual disclosure of Foladare, Moran, and Segur do not suggest the proposed combinations. Column 4, lines 10-20, of Segur discloses "a multi-format communications client-server and method that reduces the number of potential message source and translates these message to the format presently required by the user." Paragraph 0008 of Moran discloses that "[i]t would therefore be desirable to provide a scheme that would provide a much higher degree of cross-compatibility for SMS

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messaging between users having different service providers.” Paragraph 0030 of Moran discloses that “[m]essages 98 are reformatted to meet the particular requirements of the service provider for a selected destination device, capabilities of the destination device, and any applicable rules corresponding to the initial sender user and/or service provider.” Segur’s multi-format communications client-server, Moran’s disclosure of providing cross-compatibility for SMS messaging between users having different service providers, and Moran’s reformatted messages do not suggest to one of ordinary skill in the art the combination of Foladare, Moran, and Segur. The Office Action has impermissibly used hindsight occasioned by Applicants’ own teaching to reject the claims. The proposed combination of Foladare, Moran, and Segur therefore cannot support a prima facie case of obviousness. The rejection should be withdrawn and the case should be allowed.

Relations Among Claims

Independent claim 1 claims method aspects of routing digital email objects within a client device according to embodiments of the present invention. Independent claims 6 and 11 respectively claim system and computer program product aspects of routing digital email objects within a client device according to embodiments of the present invention. Claim 1 is allowable for the reasons set forth above. Claims 6 and 11 are allowable because claim 1 is allowable. The rejections of claims 6 and 11 therefore should be withdrawn, and claims 6 and 11 should be allowed.

Claims 4, 9, and 14 depend respectively from independent claims 1, 6, and 11. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Foladare, Moran, and Segur does not teach or suggest each and every element of the independent claims, so also the combination of Foladare, Moran, and Segur cannot possibly teach or suggest each and every element of any dependent claim. The rejections of claims 4, 9, and 14 therefore should be withdrawn, and these claims also should be allowed.

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Foladare, Moran, Segur, and Tsai

Claims 2, 3, 5, 7, 8, 10, 12, 13, and 15 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Foladare, et al. (U.S. Patent 6,311,210), in view of Moran, et al., (U.S. Pub. 2003/0104827), in view of Segur (U.S. Patent 6,212,550), and further in view of Tsai (U.S. Patent 6,839,741). The proposed combination of Foladare, Moran, Segur, and Tsai cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claims of the present application, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination of Foladare, Moran, Segur, and Tsai. The combination of Foladare, Moran, Segur, and Tsai therefore does not establish a prima facie case of obviousness. The rejection of claims 2, 3, 5, 7, 8, 10, 12, 13, and 15 should therefore be withdrawn and the case should be allowed.

The Combination Of Foladare, Moran, Segur, and Tsai
Does Not Teach All Of Applicants' Claim Limitations Of Claim 2

To establish a prima facie case of obviousness, the proposed combination of Foladare, Moran, Segur, and Tsai must disclose all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Claim 2 of the present application claims:

2. The method of claim 1 wherein the transcoding gateway comprises an email client, a web browser, and an HTTP server.

Regarding the rejection of claim 2, the Office Action at page 5 states that Tsai at reference numbers 112, 108, 106, 84, and 86 teach "a transcoding gateway." That is, the Office Action takes the position that reference numbers 112, 108, 106, 84, and 86 of Tsai teach "a transcoding gateway" from independent claim 1 on which dependent claim 2 depends. The transcoding gateway as claimed in the present application operates by

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"transcoding the digital object in dependence upon the display format attributes of a destination device...." What reference number 112 of Tsai actually teaches according to column 6, lines 55-57, is a "converter 112 for converting the attachments from a native format into an HTML format." Tsai's converting attachments from a native format into an HTML format cannot be transcoding a digital object in dependence upon the display format attributes of a destination device as claimed in the present application. Tsai's converting an attachment does not occur "in dependence upon the display format attributes of a destination device." In fact, converting the attachments from a native format into an HTML format does not take into account a destination device at all. According to Tsai at Figure 7, the 'converter 112' of Tsai is included in an 'attachment server 90' that also includes 'email gateway code 108,' 'web server code 106,' 'web browser 84,' and 'email program 86.' The Office Action appears to rely only on 'converter 112' of Tsai that converts attachments from a native format into an HTML format to teach transcoding a digital object as claimed in the present application. Because Tsai's converting attachments from a native format into an HTML format is not transcoding a digital object, the converter of Tsai does not teach a transcoding gateway as claimed in the present application.

The Office Action on page 5 relies on the combination of Foladare, Moran, and Segur to teach all elements of claim 1 incorporated into dependent claim 2 other than the transcoding gateway. Regarding the transcoding gateway, the Office Action also cites Tsai as a teaching reference. As explained above, Tsai does not teach a transcoding gateway as claimed in the present application. As also discussed above, the combination of Foladare, Moran, and Segur does not teach the elements of claim 1 of the present application, either as listed in claim 1 or as incorporated into claim 2. The Office Action therefore has not provided a combination of references that teaches all the elements of independent claim 1 of the present application. Because the Office Action does not teach all the elements of independent claim 1, the proposed combination of Foladare, Moran, Segur, and Tsai cannot teach all of the limitations of claim 2 of the present application.

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The Combination Of Foladare, Moran, Segur, and Tsai
Does Not Teach All Of Applicants' Claim Limitations Of Claim 3

To establish a prima facie case of obviousness, the proposed combination of Foladare, Moran, Segur, and Tsai must disclose all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Claim 3 of the present application claims:

3. The method of claim 1 wherein the a client device comprises a display device and a microcomputer, wherein the microcomputer further comprises the transcoding gateway, an email client, a web browser, and an HTTP server, wherein the transcoding gateway, the email client, the web browser, and the HTTP server are coupled for data communications.

The Office Action on page 6 relies on the combination of Foladare, Moran, and Segur to teach all elements of claim 1 incorporated into dependent claim 3 other than the transcoding gateway. The Office Action also cites Tsai as disclosing a transcoding gateway. As explained above, Tsai does not teach a transcoding gateway as claimed in the present application. As also discussed above, the combination of Foladare, Moran, and Segur does not teach the elements of claim 1 of the present application, either as listed in claim 1 or as incorporated into claim 3. The Office Action therefore has not provided a combination of references that teaches all the elements of independent claim 1 of the present application. Because the Office Action does not teach all the elements of independent claim 1, the proposed combination of Foladare, Moran, Segur, and Tsai cannot teach all of the limitations of claim 3 of the present application.

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The Combination Of Foladare, Moran, Segur, and Tsai
Does Not Teach All Of Applicants' Claim Limitations Of Claim 5

To establish a prima facie case of obviousness, the proposed combination of Foladare, Moran, Segur, and Tsai must disclose all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Claim 5 of the present application claims:

5. The method of claim 1 wherein displaying the transcoded digital object on the destination display device further comprises sending the transcoded digital object to a browser.

The Office Action on page 7 relies on the combination of Foladare, Moran, and Segur to teach all elements of claim 1 incorporated into dependent claim 5 other than the transcoding gateway. The Office Action also cites Tsai as disclosing a transcending gateway on page 6. As explained above, Tsai does not teach a transcoding gateway as claimed in the present application. As also discussed above, the combination of Foladare, Moran, and Segur does not teach the elements of claim 1 of the present application, either as listed in claim 1 or as incorporated into claim 5. The Office Action therefore has not provided a combination of references that teaches all the elements of independent claim 1 of the present application. Because the Office Action does not teach all the elements of independent claim 1, the proposed combination of Foladare, Moran, Segur, and Tsai cannot teach all of the limitations of claim 5 of the present application.

No Reasonable Expectation Of Success In The
Proposed Combination Of Foladare, Moran, Segur, and Tsai

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Foladare, Moran, Segur, and Tsai. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The present

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application is entitled "Routing Digital Email Objects Within A Client Device" and independent claim 1 includes "transcoding a digital object in dependence upon the display format attributes of the destination display device...." Foladare discloses a centralized mail device that parses incoming email messages and forwards those portions to various mail receiving devices. Foladare at column 3, lines 15-16 and lines 37-39. Moran discloses a third party message rerouting/reformatting service that reformats the text of an email message for viewing by various wireless devices. Moran at reference number 70 and paragraphs 0030 and 0038. Segur further discloses a multi-format communications client-server that converts the text of an email message to a synthesized voice message and to text for display on other devices. Segur at reference number 10 and column 2, lines 62-63, and column 2, line 65, through column 3, line 2. Tsai discloses a converter for converting email attachments from a native format into an HTML format. Tsai at reference number 112 and column 6, lines 55-57. The centralized mail device of Foladare, the third party message rerouting/reformatting service of Moran, the multi-format communications client-server of Segur, and the converter of Tsai will not work to transcoding a digital object in dependence upon the display format attributes of the destination display device as claim in the present application. The proposed combination of Foladare, Moran, Segur, and Tsai therefore cannot support a prima facie case of obviousness. The rejection should be withdrawn and the case should be allowed.

No Suggestion Or Motivation To Combine

Foladare, Moran, Segur, and Tsai

There is no suggestion or motivation to combine Foladare, Moran, Segur, and Tsai. To establish a prima facie case of obviousness under 35 U.S.C. § 103 there must be a suggestion or motivation to combine Foladare, Moran, Segur, and Tsai. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to combine Foladare, Moran, Segur, and Tsai must come from the teaching of either Foladare, Moran, Segur, or Tsai themselves, and the Examiner must explicitly point to the teaching within Foladare, Moran, Segur, or Tsai suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "hindsight"

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occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action states no rationale for motivation to combine Foladare, Moran, Segur, and Tsai other than an assertion at page 6, which states:

It would be obvious to one of ordinary skill in the art at the time of the invention to modify Foladare et al. in view of Moran et al. in view of Segur by having a transcoding gateway which comprises an email client, web browser and HTTP Server, as taught by TSAI in order to facilitate the presentation of email attachments on local email clients and web-based email clients received by a recipient (col. 2 ll. 1 ll. 6-9, col. 2 ll. 7-13).

The office action fails to explicitly point to the teaching within Foladare, Moran, or Segur suggesting the proposed combination. Without more, the rejection should be withdrawn.

The actual disclosure of Foladare, Moran, and Segur do not suggest the proposed combinations. Column 2, line 1, of Tsai discloses that Tsai's "electronic mail message includes both text and an attachment." Column 2, lines 6-13, of Tsai discloses the following:

In accordance with another aspect of the present invention, an attachment for an electronic mail message is stored on a first computer system. The electronic mail message is sent without the attachment from a sender to at least one recipient on a second computer system. The recipient is enabled to remotely access the attachment of the first computer system from the second computer system.

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Tsai's electronic mail message and system for distributing and providing access to electronic mail message attachments do not suggest to one of ordinary skill in the art the combination of Foladare, Moran, Segur, and Tsai. The Office Action has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. The proposed combination of Foladare, Moran, Segur, and Tsai therefore cannot support a prima facie case of obviousness. The rejection should be withdrawn and the case should be allowed.

Relations Among Claims

Claim 2 claims method aspects of routing digital email objects within a client device according to embodiments of the present invention. Claims 7 and 12 respectively claim system and computer program product aspects of routing digital email objects within a client device according to embodiments of the present invention. Claim 2 is allowable for the reasons set forth above. Claims 7 and 12 are allowable because claim 2 is allowable. The rejections of claims 7 and 12 therefore should be withdrawn, and claims 7 and 12 should be allowed.

Claim 3 claims method aspects of routing digital email objects within a client device according to embodiments of the present invention. Claims 8 and 13 respectively claim system and computer program product aspects of routing digital email objects within a client device according to embodiments of the present invention. Claim 3 is allowable for the reasons set forth above. Claims 8 and 13 are allowable because claim 3 is allowable. The rejections of claims 8 and 13 therefore should be withdrawn, and claims 8 and 13 should be allowed.

Claim 5 claims method aspects of routing digital email objects within a client device according to embodiments of the present invention. Claims 10 and 15 respectively claim system and computer program product aspects of routing digital email objects within a client device according to embodiments of the present invention. Claim 5 is allowable for the reasons set forth above. Claims 10 and 15 are allowable because claim 5 is

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allowable. The rejections of claims 10 and 15 therefore should be withdrawn, and claims 10 and 15 should be allowed.

Conclusion

Claims 1, 4, 6, 9, 11, and 14 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Foladare, *et al.* (U.S. Patent 6,311,210), in view of Moran, *et al.*, (U.S. Pub. 2003/0104827), and in view of Segur (U.S. Patent 6,212,550). As explained above, the combination of Foladare, Moran, and Segur does not establish a prima facie case of obviousness. The rejection of claims 1, 4, 6, 9, 11, and 14 should therefore be withdrawn, and the claims should be allowed. Applicants request reconsideration of claims 1, 4, 6, 9, 11, and 14 in light of the present remarks.

Claims 2, 3, 5, 7, 8, 10, 12, 13, and 15 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Foladare, *et al.* (U.S. Patent 6,311,210), in view of Moran, *et al.*, (U.S. Pub. 2003/0104827), in view of Segur (U.S. Patent 6,212,550), and further in view of Tsai (U.S. Patent 6,839,741). As explained above, the combination of Foladare, Moran, Segur, and Tsai does not establish a prima facie case of obviousness. The rejection of claims 2, 3, 5, 7, 8, 10, 12, 13, and 15 should therefore be withdrawn, and the claims should be allowed. Applicants request reconsideration of claims 2, 3, 5, 7, 8, 10, 12, 13, and 15 in light of the present remarks.

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The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Date: October 25, 2005

By: _____

Respectfully submitted,


H. Artoush Ohanian

Reg. No. 46,022

Biggers & Ohanian, LLP

P.O. Box 1469

Austin, Texas 78767-1469

Tel. (512) 472-9881

Fax (512) 472-9887

ATTORNEY FOR APPLICANTS